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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/092,488	06/05/1998	TEDDY C. JOHNSON	10980822-1	6145

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EXAMINER

SOUGH, HYUNG SUB

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 11/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/092,488	JOHNSON, TEDDY C.
	Examiner	Art Unit
	Hyung S. Sough	2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 August 2001 .

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3 and 6-19 is/are pending in the application.

4a) Of the above claim(s) 8-10 and 12-19 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3, 6, 7 and 11 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on 04 September 2001 is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____ .

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 20) Other: _____ .

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Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 4, 2001 have been approved by the Draftsperson.

Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 6, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the disclosed prior art in view of Joffe et al (Joffe hereinafter: US PAT. 6,185,619 B1) and Kawaguchi (US PAT. 5,832,527).

The disclosed prior art (Fig. 1) shows a system having (a) a host machine for running a plurality of processes (i.e., Web server, FTP server, and customer database), the host machine residing an unsecured side of a firewall (i.e., an external side of the firewall); and (b) a filing storage system accessible by the host machine having a storeroom area and a customer account.

Re claims 1, 7, and 11: The disclosed prior art does not show the following features:

(1) a plurality of host machines for running a plurality of processes located an unsecured side of a firewall;

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(2) at least one secure communication link between the plurality of host machines.

(3) hard file links comprising pointers to files between the storeroom area and the customer account area; and

(4) at least one secured host machine located on the secured side of the firewall, wherein the secured host machine comprises a customer account database which is accessible by at least one of the plurality of host machines across a second secure communication link through the firewall.

However, these differences between the subject matter sought to be patented and the disclosed prior art do not render the claimed construction patentable for the following reasons.

(1) Joffe discloses the use of a plurality of servers for running a plurality of processes (see column 2, lines 8-9) to solve “The problems of latency and bandwidth constraints” (see column 1, lines 51-53). Thus, It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a plurality of host machines for running a plurality of processes as disclosed by Joffe to solve “The problems of latency and bandwidth constraints”. Further, It would have been within the level ordinary skill in the art at the time the invention was made to employ a plurality of host machines for running a plurality of processes, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

Nerwin v. Erlichman, 168 USPQ 177, 179.

(2) It is well-known and fundamental practice in the art to employ secure communication links (e.g., cryptography) to protect against unauthorized access, operation or

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use of any web site, server or network system, and it would have been common sense to use secure communication links to any web site, server network including the host machines as claimed as desired.

(3) Kawaguchi teaches the use of hard link having a pointer to provide a file management system that improves disk space efficiency, simplifies file management, and incorporates data to access stored objects. Thus, it would have been within a level of ordinary skill in the art to modify the disclosed prior art by adopting the teaching of Kawaguchi (i.e., linking files) to provide a filing storage system (i.e., a file management system) that improves disk space efficiency, simplifies file management, and incorporates data to access stored objects.

(4) As stated supra, Joffe discloses the use of separate host machines for running a plurality of processes (see column 2, lines 8-9) to solve "The problems of latency and bandwidth constraints" (see column 1, lines 51-53). Thus, It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a separate host machine having a customer account database to solve "The problems of latency and bandwidth constraints". Further, It would have been within the level ordinary skill in the art at the time the invention was made to employ a separate host machine for a customer account database, since it has been held that constructing a formerly integral structure (i.e., a host machine having Web server, FTP server and a customer database) in various elements (i.e., a host machine having Web server, a host machine having FTP server, and a host machine having a customer database)

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involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Still further, one of the basic problems in the art is to keep the customer account database (which generally contains sensitive information, i.e., credit card numbers, phone numbers and addresses) secure, and it would have been common sense to employ a secured host machine located on the secured side of the firewall to enhance the security of the customer account database. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the host machine having the customer account database at any desirable location including the claimed location to enhance the security of the customer account database, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Moreover, the customer account database (which is used for authorizing the customer to a specific web site and charging the fee) must be accessible by at least one of the plurality of host machines across a second secure communication link through the firewall.

Re claims 2, 3, and 6: None of the cited prior art explicitly discloses the use of various claimed secure communication links (i.e., protocol recited in claim 2, DES, or tobj protocol). However, these are well-known protocols used for secure communication, and nothing unobvious is seen to have been involved simply having employed these well-known protocols for transferring data over the Internet to provide the security to the data transfer.

Response to Arguments

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4. Applicant's arguments filed August 23, 2001 have been fully considered but they are not persuasive for the following reasons:

• In response to applicant's argument that there is no motivation, teaching or suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Further, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art, *In re McLaughlin*, 170 USPQ 209 (CCPA 1971), and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969. In this case, as stated supra, Joffe clearly provides motivation to use a plurality of servers for running a plurality of processes (see column 2, lines 8-9) to solve “The problems of latency and bandwidth constraints” (see column 1, lines 51-53) and Kawaguchi clearly teaches the use of hard link having a pointer to

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provide a filing storage system (i.e., a file management system) that improves disk space efficiency, simplifies file management, and incorporates data to access stored objects.

• In response to applicant's argument that "The reasoning for the use of Joffe is apparently to solve 'the problems of latency and bandwidth constraint.' However, the focus of the application at hand is secured data transfers, not latency and bandwidth constraints.", the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter* , 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon* , 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). Although *Ex parte Levingood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do **what the patent applicant has done**", reading the quotation in context it is clear that while there must be motivation to make the claimed invention, **there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.**

• In response to Applicant's request "that the Examiner provide the prior art from which claim 1 was rearranged.", applicant's attention is directed to the fact that the claimed elements would have been obvious for the reasons stated *supra* and the obviousness of rearranging the elements (i.e., to locate the host machine having the customer account database

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at any desirable location including the claimed location to enhance the security of the customer account database) is based on the legal decision (i.e., *In re Japikse*, 86 USPQ 70). In MPEP § 2144, it states:

if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.

If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

However, Applicant has not demonstrated the criticality of a specific limitation (i.e., to locate the host machine having the customer account database at any desirable location including the claimed location) beyond the well-known motivation in the art (i.e., to enhance the security of the customer account database) which would have been obvious to one of ordinary skill in the art. Thus, it would be appropriate to rely solely on case law (i.e., *In re Japikse*, 86 USPQ 70 and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) as the rationale support the examiner's obviousness rejection.

- In response to Applicant's assertions that none of the references discloses that "the filing storage system ... pointers to files." (Page 7, lines 1-4) and "a customer account database ... link through the firewall." (Page 7, lines 8-10), applicant's attention is directed to the fact that, as stated *supra*, the rejections are based on combinations of references and one

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cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

• In response to Applicant's request "that the Examiner provide a reference that discloses the claimed protocol in conjunction with the limitations of claim 1." and request to provide "any references that disclose the elements of claim 7 with the limitations of claim 1", applicant's attention is directed to the fact that the rejection is under **35 U.S.C. § 103 which is used for a rejection when there is no single reference that suggests or discloses all the elements claimed.** Thus, Applicant's request is moot.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

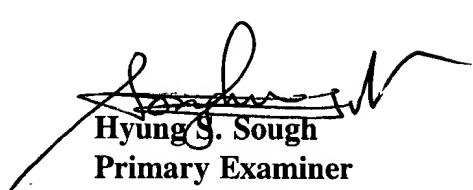
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P. Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax numbers are (703) 746-7238 for After-final, (703) 746-7239 for Official, and (703) 746-7240 for Non-Official/Draft.



Hyung S. Sough
Primary Examiner
Art Unit 2161

shs

November 17, 2001